

REMARKS/ARGUMENTS

This is in response to the official action dated June 23, 2008. Reconsideration is respectfully requested.

Claim Objections

The Examiner objected to claim 10 because of the following informalities:

In line 1, "supply" should be replaced with --supplying--. Applicant has made appropriate correction.

Drawings:

The Examiner stated that the drawing dated January 4, 2004 have uneven and/or degraded lines making it difficult to identify some details. Applicant submits herewith a new sheet of figures.

Claim rejections under 35 USC § 102

The Examiner rejected claims 6 and 9 as being anticipated by Takasu (US 5,236,414).

Anticipation requires identity of invention. *See* MPEP 2131. *See also Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claims. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). There must be no differences between what is claimed and what is disclosed in the prior art reference. *In re Kalm*, 154 USPQ 10, 12 (CCPA 1967.)

Applicant submits that the present invention differs from Takasu in several aspects. Takasu teaches a fat sucking apparatus which includes a tubular body (11) encapsulated by an outer cooling tube (30). Between the two tubes, a suction passage is defined which has at least one suction opening at the front lower end of the tubular body, a hand piece to which the tip is detachably connected and which has therein a suction passage which is connected to the suction passage of the tip. The hand piece is connected to an ultrasonic oscillation generator. The

ultrasonic oscillation is being transmitted to the tip of the tubular body tip. The outer tube is equipped with a suction opening. The apparatus of Takasu is inserted into fatty tissue and upon generating ultrasonic oscillations, the fat in the tissues is dissolved and a collector which is connected to the suction passage receives the dissolved fat, which is then transported through the channel to a collector.

Takasu does not teach (and does not need) a supply device (1) which including a vacuum pump (3), and a supply pump (5, 7) for injecting a separation fluid or a process fluid for suctioning off separated or dissolved tissue cells and/or the separation fluid or the process fluid. Neither does Takasu teach a surgical hand piece (2) with an inner injection cannula (19) and an outer suction tube (23), both of which form an annular suction channel in the region of the surgical hand piece (2), wherein the outer suction tube (23) is adapted to be placed on the injection cannula (19) and to be secured to the surgical hand piece (2), and wherein the injection cannula (19) includes a front nozzle opening (20) and the suction tube (23) includes a plurality of suction bores (24) distributed along its periphery. Takasu instead provides a cooling channel with openings which are distributed parallel to the axis such that the effected tissue area is only on one side of the inserted device. Thus, applicant's invention as claimed is not anticipated by Takasu.

Claim rejections under 35 USC § 103

The Examiner rejected claims 7 and 8 as being obvious over Takasu in view of Boutboul (FR 2 700 958). The Examiner rejected claim 10 as being unpatentable over Takasu in view of Comescu (US 5,836,909) and Butsch et al. (US 7,063,713). A claim is properly rejected as obvious over a reference only when the differences between the claimed subject matter and the reference would have been obvious to a person of ordinary skill in the field at the time that the claimed invention was made. In addition, when an obviousness rejection is made over a combination of references, it must also have been obvious to a person of ordinary skill to combine the references as suggested by the Examiner. The Examiner states that Takasu would not disclose specifically "complementary handles" and that Boutboul would provide such handles. Applicant submits that the combination of the references would result in Applicant's invention. It would require to exchange the inner end piece (10) with handle (20) of Takasu

would have to be exchanged with the probe (4) of Boutboul. This however would result into a similar device as the one of Takasu, but for being operated with ultrasound. Such design would not render obvious what applicant's claim in claim 7 and 8.

Concerning claim 9 and 10, Applicant submits that the combination of Takasu and Comecu or Butsch does not render obvious these claims. Butsch teaches the use of several supply pumps, which all work with the same supply fluids. Butsch uses instead of the supply pump several sub pumps, comprising several cartridges. For a better regulation of the content of each cartridge, and the need of separation fluid, several cartridges are being used as needed. Thus, Butsch does not teach any supply arrangement with different working fluids.

Further, the fluid jet arrangement of Butsch can not be combined with Takasu, because Takasu works with ultrasonic oscillation which does not require fluid jet arrangement.

The same is the case for Comesu, who teaches a system for laser surgery and electro surgery, which utilizes one or several container(s) 1 and 2 of the same working fluid. Thus, the combination of references would not render claims 9 and 10 obvious.

Thus, applicant submits that the claims, as amended, are patentable over the references cited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,
NORRIS McLAUGHLIN & MARCUS, P.A.

By *Christa Hildebrand*
Christa Hildebrand
Reg. No. 34,953
875 Third Avenue - 18th Floor
New York, New York 10022
Phone: (212) 808-0700
Fax: (212) 808-0844
Facsimile: (212)808-0844